

REMARKS

The foregoing amendment amends claims 1 and 17 to include subject matter of canceled claims. Consequential amendments are also made to claims 6 and 11. Claims 7, 14, 15, 16, 20 and 21. Therefore, the amendment raises no new issues, and entry is in order. Pending in the application are claims 1-6, 8-13 and 17-19, of which claims 1 and 17 are independent. The following comments address all stated grounds for rejection and place the presently pending claims, as identified above, in condition for allowance.

Claims 1 is amended to include the subject matter of canceled claims 15 and 16. Claim 17 is amended to include the subject matter of claim 21. Namely, claims 1 and 17 now specify that the extended portion of the sealing member extends through a groove or over a flat surface defined between two protruding members formed on a first surface of a separator. *No new matter is added.*

Amendment and/or cancellation of the claims are not to be construed as an acquiescence to any of the objections/rejections set forth in the instant Office Action, and were done solely to expedite prosecution of the application. Applicants reserve the right to pursue the claims as originally filed, or similar claims, in this or one or more subsequent patent applications.

Claim Rejections Under 35 USC §102

In the Office Action, the Examiner maintains and finalizes the rejection of claims 1-21 under 35 U.S.C. § 102(e) as being anticipated by Nishida (JP 2000-021418). Applicants respectfully traverse the rejection for the following reasons.

In the Nishida reference, which corresponds to Figure 19 of the present application and the corresponding description, a gasket portion on a fuel cell separator includes connecting members (i.e., the phenol projecting parts 5 and joint members 15) that abut protruding members 3 or 2 of the separator to form a boundary portion of a gas channel. The connecting members of the gasket form a boundary portion or sidewall of the gas channel only along a *peripheral edge*

of the separator, while the protruding members of the separator, which is not a sealing member, define a boundary portion or sidewall of the gas channel across the surface of the separator. In contrast to the claimed invention, the connecting members of the gasket of Nishida merely extend a nominal, non-significant distance from one end of the gasket portion and stop short of extending into the surface area defined by the protruding members.

In particular, the Nishida reference does not disclose a sealing member having an extended portion that extends seamlessly from a circumferential portion *between protruding members* of a separator that are formed on a surface of a separator, as recited in independent claims 1 and 17 and previously recited in canceled claims 6, 7 and 21. According to the Examiner on page 5 of the Office Action, “the extended portion of Nishida extends seamlessly from said circumferential portion in a longitudinal direction to an end portion...between different surface features to form the turning portion of the channel on the separator face.” The Examiner has not, however, explained his position that the “requirement in the claim that the connecting members extend between the protruding members on a separator is met by the reference”, because it is clear that the joint members of Nishida stop short of extending *between* the linear protruding members 2 or 3 of the separator. Applicants request that the Examiner explain what portion of the sealing gasket he considers to extend “between protruding members on a separator”, as it is unclear from the Office Action.

The joint members of Nishida fail to extend *between* adjacent protruding members 2 or 3 or any other adjacent components of the separator of Nishida that could be considered linear protruding members on a separator surface forming grooves between adjacent protruding members, as recited in claims 1 and 17. As shown, in Figure 2 and 3 of Nishida and described in the “Background” section of the present application, the connecting members of the gasket in Nishida abut, but clearly do not extend *between* the protruding members on the separator. The connecting members extend only in an area that the protruding members are absent.

In fact, the Nishida reference teaches *away* from having an extending portion of a sealing member extend between linear protruding members on a surface of a separator, because Nishida requires that the end portion of an extending portion abut an end of a protruding

member, which precludes extension of the sealing member between two adjacent protruding members. In addition, there would be no space between the protruding members of Nishida to accommodate a sealing member. Therefore, not only does Nishida fail to disclose the subject matter of claims 1 and 17, Nishida in fact expressly teaches away from the claimed invention.

For at least these reasons, the Nishida reference fails to disclose all of the elements of the claimed invention. As such, Applicants request that the rejection in view of Nishida be reconsidered and withdrawn.

CONCLUSION

In view of the above amendment, applicants believe the pending application is in condition for allowance.

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 227-7400.

Applicants believe no fee is due with this Amendment. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. SIW-016RCE from which the undersigned is authorized to draw.

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Respectfully submitted,

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